



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/740,486	12/19/2000	Alan S. Waggoner	92053CONCIPCON	6161

7590 02/26/2002

Christine R. Ethridge, Esq.  
Kirkpatrick & Lockhart LLP  
Henry W. Oliver Building  
535 Smithfield Street  
Pittsburgh, PA 15222-2312

EXAMINER

PONNALURI, PADMASHRI

ART UNIT

PAPER NUMBER

1627

DATE MAILED: 02/26/2002

9

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. <b>09/740,486</b>	Applicant(s) <b>Waggoner</b>
	Examiner <b>Padmashri Ponnaluri</b>	Art Unit <b>1627</b>

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)  Responsive to communication(s) filed on Dec 12, 2001

2a)  This action is FINAL. 2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

**Disposition of Claims**

4)  Claim(s) 9-24 is/are pending in the application.

4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) \_\_\_\_\_ is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claims 9-24 are subject to restriction and/or election requirement.

**Application Papers**

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

11)  The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved.

12)  The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. § 119**

13)  Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) All b) Some\* c) None of:

1.  Certified copies of the priority documents have been received.
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

14)  Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

**Attachment(s)**

15)  Notice of References Cited (PTO-892) 18)  Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_

16)  Notice of Draftsperson's Patent Drawing Review (PTO-948) 19)  Notice of Informal Patent Application (PTO-152)

17)  Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 20)  Other: \_\_\_\_\_

Art Unit: 1627

1. The preliminary amendment A, filed on 12/9/01; and preliminary amendment B, filed on 12/12/01 have been fully considered and entered into the application.
2. Claims 1-8 have been canceled, and new claims 9-16 have been added by the amendment A, and claims 17-24 have been added by the amendment B.
3. Claims 9-24 are currently pending in this application.

**Please Note:** In an effort to enhance communication with our customers and reduce processing time, a dedicated Fax machine is in place to receive your responses. The Fax number is 703-308-4315. A Fax cover sheet is attached to this Office Action for your convenience. We encourage your participation in this Pilot program. If you have any questions or suggestions please contact Jyothsna Venkat, Ph.D., Supervisory Patent Examiner at [jyothsna.venkat@uspto.gov](mailto:jyothsna.venkat@uspto.gov) or 703-308-2439. Thank you in advance for allowing us to enhance our customer service. Please limit the use of this dedicated Fax number to responses to Written Restrictions.

***Election/Restriction***

4. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 9-12, drawn to a method for imparting luminescence to a component, classified in class 436, subclass 172.

Art Unit: 1627

- II. Claims 13-16, 20, drawn to a component label with a luminescent cyanine dye, classified in class 514, subclass 183.
- III. Claims 17-19, drawn to a luminescently labeled component of an aqueous liquid, classified in class 514, subclass 183.
- IV. Claim 21, drawn to a method of detecting a component in a sample, classified in class 435, subclass 4.
- V. Claim 22, drawn to a method of detecting the presence of a secondary component in a sample, classified in class 435, subclass 7.93.
- VI. Claims 23-24, drawn to a method for distinguishing a plurality of secondary components, classified in class 435, subclass 4.

- 5. The inventions are distinct, each from the other because of the following reasons:
- 6. Inventions of groups I, IV, V and VI are drawn to different methods and the use of luminescent dye. All these methods have different method steps. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions of group I are drawn to a method of labeling a component; which has different method steps and end product different from groups IV-VI inventions. The inventions of groups IV - VI are drawn to method of identifying the component which is labeled. The group IV and group V, group VI differ from each other because the method steps in identifying the component are different and group VI method identifies multiple components.

Art Unit: 1627

7. Inventions of group II and group III are drawn to different products. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions . The products of groups II are drawn to a component labeled with a **luminescent cyanine dye**; which is different from the group III component labeled with a **luminescent dye (cyanine, merocyanine or styryl dyes)**. Thus, restriction between the groups is proper.

8. Inventions of group I and groups II, III are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the method of labeling of group I method can be used to label different components, and the use of different dyes; and the product of groups II, III can be made using different process.

9. Inventions of groups II-III and groups IV-VI are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the different products of groups II and III can be

Art Unit: 1627

used in several different methods such as groups IV-VI. Thus, restriction between the groups is proper.

10. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification and because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

11. This application contains claims directed to the following patentably distinct species of the claimed invention: Applicants are requested to elect a single species for each of the following:

- a) If either group I, or II or III is elected, applicants are requested to elect a single component ;
- b) if either group I or II is elected applicants are requested to elect a single reactive group;
- c) if either group III or group IV or V or VI is elected, applicants are requested to elect a single type of dye (i.e., cyanine, merocyanine, styryl dye)

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 9, 13 are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable

Art Unit: 1627

thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

12. A telephone call was made to Attorney Arthur Crawford on 2/15/02 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Art Unit: 1627

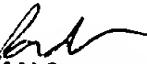
13. Applicant is required to reply to this restriction requirement within 30 days of mailing this action. See MPEP 809.2(a).

Any inquiry concerning this communication should be directed to P. Ponnaluri whose telephone number is (703) 305-3884. The examiner can normally be reached on Monday through Friday from 8:00 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jyothsna Venkat, can be reached at (703)308-2439. The fax number for this group is (703)305-3014.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the group receptionist whose telephone number is (703)308-0196.

P. Ponnaluri  
Patent Examiner  
Technology center 1600  
Art Unit 1627  
20 February 2002

  
**PADMASHRI PONNALURI**  
**PRIMARY EXAMINER**